

USSN 10/032,370

**RECEIVED**  
**CENTRAL FAX CENTER**  
**OCT 31 2008****REMARKS**

Claims 1-7, 10-22, 33, 34, 45, 48-51 and 53-64 are pending in the Application. By the Office Action dated October 28, 2008, the Examiner asserts that these claims are subject to restriction and/or election requirement. Specifically, the Examiner asserts that a restriction is required under 35 USC 121 as between:

Invention I – claims 1-7, 10-22, 33-34, 48-49 and 55-64 drawn to a high aspect ratio antimicrobial additive classified in class 424, subclass 451 and

Invention II – claims 45, 50-51, and 53-54 drawn to a method of altering the release characteristics of an inorganic antimicrobial agent from a polymer matrix classified in class 424, subclass 462.

In Paragraph 2 of the Office Action it is alleged that the two inventions are related as process of making and product made. It is stated that inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process. According to the statement of the Examiner, "[I]n the instant case the product's release may be altered by comprising the antimicrobial additive in hydrophobic polymer or by incorporating the antimicrobial in a polymer matrix."

In Paragraph 3 of the Office Action it is stated that restriction for examination purposes is proper because the claimed inventions are independent or distinct for the reasons set forth in Paragraph 2 and there would be a serious search and examination burden if restriction were not required because of one or more of a list of reasons. (Emphasis in original)

In compliance with Applicants' obligation to elect an invention for examination, Applicants elect Invention I, claims 1-7, 10-22, 33-34, 48-49 and 55-64, with traverse. Applicants respectfully requests that all claims remain in the active examination of this application.

The first element in assessing whether a restriction requirement is proper is a determination that the inventions are distinct. Although the Examiner alleges distinction, the undersigned is at a loss to understand the basis for the alleged distinction as set forth in Paragraph 2. The undersigned does not appreciate how the conclusory remark of that paragraph fits either of conditions (1) or (2). Hydrophobic polymers are a subset of the more general polymer matrix. Clarification is respectfully requested.

Second, for a restriction to be proper, it must also be shown that there would be a serious search and examination burden if restriction were not required because of one or more of a list of enumerated reasons. Even assuming for the moment that distinction had been established, the Examiner provides no particular reason or guidance as to which of the enumerated reasons apply for why the search and examination would be a serious burden. Hence, again the restriction requirement is improper or fails in that it is not properly established.

USSN 10/032,370


Finally, in any event, it is incredulous to the undersigned that the Examiner makes an allegation that "there would be a serious search and examination burden" if the restriction were not made, particularly at this late stage of examination. The instant application has been in active prosecution for more than 5.5 years. Following an initial restriction requirement, one in which no distinction was made between the instant method and product claims, claims of both Inventions I and II have been repeatedly prosecuted. In fact, there have been no less than six substantive office actions and two advisory actions in which both the method and product claims, now alleged to present a serious burden for search and examination, were specifically rejected. Furthermore, this is the third Request for Continued Examination (RCE) and up to now, no concern has been raised with respect to an undue burden. To the contrary, as mentioned, in each of the six Office Actions, the claims have been rejected on the basis of the searches and examinations conducted. How then it is possible that one can now decide that there is a serious burden?

Applicant respectfully requests that all claims be retained in the instant application and examined on their merits.

Applicants believe the instant claims are patentable over the art of record for the reasons previously presented. Furthermore, Applicant once again directs the Examiner's attention to Applicants' related patent application no 10/032,372, now US 7,357,949, where similar patentability considerations were raised and successfully addressed.

Applicants believe this is a complete response to the Office Action. Should there be any unanswered or additional questions the Examiner is requested to contact the undersigned. Otherwise, Applicants respectfully requests that the claims be passed on to allowance.

Respectfully submitted,



Edward K. Welch II  
Attorney for Applicant  
Registration No. 30,899  
IP&L Solutions  
4558 Ashton Court  
Naples, FL 34112  
Tel.: 781-718-9512  
e-mail: welched@comcast.net